

Application No.: 10/783107
Amendment dated: January 27, 2006
Reply to Office action of October 28, 2005

REMARKS/ARGUMENTS

The applicants request reconsideration of the objection to the preliminary amendment. The declaration submitted herewith under Rule 132 supplements the record and shows how the error (the inadvertent substitution of a colon (:) for the symbol μ) would have been readily apparent to one skilled in the art. If the showing is acceptable, the Examiner is requested not to enter the above amendment to the specification.

Concerning the order of the layers, it does not matter whether the anti-rewetting layer is on the web contacting side relative to the base body, or on the roll-contacting side, although it will ordinarily be on the web-contacting side. What is important is that the anti-rewetting layer is disposed within the batt. To avoid confusion, claim 1 has been amended to refer to a "batt" rather than to a "batt layer." The claim has also been amended to recite that "the base body and the anti-rewetting layer" are "both disposed within the batt."

Concerning the rejection of claims 1 and 2 under §102(b) on Eklund, claim 1 now clearly distinguishes the invention from Eklund by reciting that the anti-rewetting layer is disposed within the batt and spaced from the wet paper web contacting surface. Eklund, on the other hand, describes a permeable sheet assembly in which a thermoplastic foil having though holes is disposed on one of the faces of the structure.

Concerning the rejection of claims 1 and 5-8 under 35 U.S.C. §102(a) on Watanabe, the applicants submit herewith a verified translation of their priority document, Japanese patent application 48970/2003, which was filed February 25,

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2003. The filing date of the priority document precedes Watanabe's March 20, 2003 publication date, and therefore, the Watanabe is not available as a reference for the purpose of §102(a). That is, the present invention is now shown to have been made before the subject matter of Watanabe's application was "known or used by others in this country" or "described in a printed publication in this or a foreign country."

In the rejection of claims 1 and 5-8 under 35 U.S.C. §102(e) on Watanabe, the Examiner has pointed to Watanabe's paragraph 0049. Paragraph 0049 states that, when a biaxially oriented film is used, splitting and film rupture may be prevented. On the basis of paragraph 0049, the Examiner concluding that Watanabe implicitly teaches that the use of an unoriented film is less preferred but known. For the reasons set forth below, Watanabe does not anticipate the claimed invention under section 102(e), and is unavailable as a reference by virtue of section 102(e) for the purpose of an obviousness rejection under section 103.

Lack of novelty, or "anticipation," under section 102 "can only be established by a single prior art reference which discloses each and every element of the claimed invention." Structural Rubber Products Co. v. Park Rubber Co., 749 F.2d 707, 715, 2323 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984). In Connell v. Sears Roebuck & Co., 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983), Chief Judge Markey strongly criticized the use of section 102 as a basis for holding a claim unpatentable in a situation where all the elements of the claim were not disclosed in a single reference. The relevant portion of his remarks concerning a trial court's opinion are as follows:

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The opinion says anticipation may be shown by less than "complete anticipation" if one of ordinary skill may in reliance on the prior art "complete the work required for the invention", and that "it is sufficient for an anticipation 'if the general aspects are the same and the differences in minor matters is only such as would suggest itself to one of ordinary skill in the art.'" Those statements relate to obviousness, not anticipation. Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. . . . A prior art disclosure that "almost" meets that standard may render the claim invalid under §103; it does not "anticipate."

The Court of Appeals for the Federal Circuit stated the rule in slightly different terms in Verdegaal Brothers, Inc. v. Union Oil Company of California, 814 F. 2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.

There is no express disclosure of an unoriented film in Watanabe, nor is it "inherently described." Inherent description, or "inherency," exists where missing descriptive matter is necessarily present in the thing described in the reference. In re Robertson, 169 F. 3d 1743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). Applying the principles set forth in Robertson, there is clearly no inherent disclosure of an unoriented film in Watanabe. The Examiner has also noted that Watanabe's claims are not limited to an oriented film. We take this as implying that, because Watanabe's independent claim is not limited by film orientation, Watanabe discloses a genus, namely a press felt having a film with three-

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dimensional openings, and that the disclosure of the genus amounts to a disclosure of each of the species within the genus.

A claim, of course, is entitled to be as broad as the prior art will permit. It does not follow logically from the fact that Watanabe's independent claim is not limited to a particular film orientation, that Watanabe's patent discloses a press felt containing an unoriented film as a rewetting-prevention layer.

Finally, it should be noted that an unoriented film is not the only alternative to a biaxially oriented film. A uniaxial orientation is also possible. Thus, aside from the legal obstacles mentioned above, there is no factual basis for a conclusion that Watanabe discloses the use of unoriented film.

In summary, while Watanabe may well raise an issue of obviousness under section 103 insofar as the present claims are concerned, it does not anticipate them under section 102. There are other reasons why section 103 is inapplicable, which will be discussed below specifically in response to the rejection of claims 2 and 3 under section 103(a).

Watanabe is unavailable as a reference for the purpose of the rejections of claims 2-3 under section 102(a), for the same reasons as set forth above with respect to the rejection of claims 1 and 5-8 under §102(a).

Concerning the rejection of claims 2-3 under §102(e), these claims are dependent on claim 1 and we submit are patentable for the same reason as set forth above concerning the rejection of claims 1 and 5-8 under §102(e).

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Concerning the rejections of claims 2 and 3 under section 103(a) as obvious in view of Watanabe, the Watanabe published application could be prior art for the purpose of section 103, under either section 102(a) or 102(e). We have already pointed out how Watanabe is unavailable as a 102(a) reference. Concerning its availability as prior art by virtue of section 102(e), the declaration under Rule 132 establishes that the present invention and Watanabe's invention were owned by the same person or subject to an obligation of assignment to the same person at the time the present invention was made, and therefore within the exception set forth in 35 U.S.C. §103(c)(1).

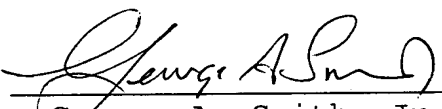
Concerning the rejections of claims 3-4, 7-8 under section 103(a) on Eklund and Gulya and claims 5 and 6 on Eklund, as noted previously, Eklund does not teach a structure in which a layer having holes is disposed within a batt and spaced from a wet paper web contacting surface. In fact Eklund has nothing to do with the prevention of re-wetting, and consequently there is no basis for concluding that the invention of claims 3-8 would have been obvious from Eklund, either alone, or in combination with Gulya. New claim 9 is similar to claim 1. Unlike claim 1, claim 8 does not require the anti-rewetting layer to be spaced from the web-contacting surface. However, it more completely defines the configuration of the openings, as "being in the form of a tapered, three-dimensional, structure protruding from the second side of the film toward the roll-contacting surface. . . ." There are no protrusions in Eklund or Gulya. Dependent claims 10-16 correspond to claims 2-8. In view of the new

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claims, the applicants submit herewith a terminal disclaimer to avoid any obviousness-type double patenting.

Favorable reconsideration and allowance of this application are respectfully requested in view of the above amendments and remarks.

Respectfully submitted,
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Enclosures:

- (a) declaration under Rule 132
- (b) verified translation of priority document
- (c) terminal disclaimer
- (d) disclaimer fee